

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Jonathan D. ZOOK *et al.*) ATTN: Office of Petitions
)
Application No.: 10/644,389) Group Art Unit: 1711
)
Filed: August 19, 2003) Examiner: Duc TRUONG
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For: SEALANTS AND POTTING)
FORMULATIONS INCLUDING)
MERCAPTO-TERMINATED)
POLYMERS PRODUCED BY THE)
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Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION UNDER 37 C.F.R. § 1.78(a)(3) TO ACCEPT AN
UNINTENTIONALLY DELAYED CLAIM FOR DOMESTIC PRIORITY**

During an interference involving this application, *Zook v. Zook*, Patent Interference No. 105,555 (MPT), it was noted that an alternative priority benefit chain, not the basis of priority in the interference, appeared to include some errors. Applicants hereby submit this petition under 37 C.F.R. § 1.78(a)(3) to accept an unintentionally delayed claim for priority under 35 U.S.C. § 120.

The above-referenced application includes a valid priority claim under 35 U.S.C. § 120 to a benefit chain, namely, to Application No. 10/302,177, filed November 21, 2002, now abandoned, which is a continuation of Application No. 09/756,573, filed on January 8, 2001,

now U.S. Patent 6,509,418, which is a continuation-in-part of Application No. 08/928,972, filed September 12, 1997, now U.S. Patent 6,172,179, which is a continuation-in-part of Application No. 08/802,130, filed February 19, 1997, now U.S. Patent 5,912,319.¹

Application No. 10/644,389's priority claim involving Application No. 09/318,500, filed May 25, 1999, now U.S. Patent 6,232,401, however, is in error as it indicates that the above-referenced application, serial No. 10/644,389 ("the '389 application"), is a continuation-in-part of Application No. 09/318,500. The '389 application also erroneously sets forth the relationship of U.S. Provisional Application Nos. 60/182,396 and 60/215,548. The '389 application is not a continuation-in-part of Application No. 09/318,500, it is instead a continuation of 10/388,177, which is a continuation of Application No. 09/756,573, which is, *inter alia*, a continuation-in-part of Application No. 09/318,500, which itself is, *inter alia*, a divisional of Application No. 08/802,130. Application No. 09/756,573 also claims the benefit of the recited provisional applications.

According to 37 C.F.R. § 1.78(a)(2)(ii), the reference to the prior-filed application was to be submitted during the pendency of the later-filed application and within the later of four months from the actual filing date of this application or sixteen (16) months from the filing date of the prior-filed application. As this application was filed on August 19, 2003, and the '500 application was filed on May 25, 1999, the later of four months from the filing date and sixteen months from the filing date of the prior-filed application is four months from the filing date, namely, December 19, 2003.

¹ While the filing date of Application No. 10/302,177 is recited in error as November 21, 2001, not 2002, the reference required under 35 U.S.C. § 120 and 37 C.F.R. § 1.78 to claim the benefit of priority requires identification by application number and by the relationship between the applications. 35 U.S.C. § 120; 37 C.F.R. §§ 1.14 and 1.78. This requirement was met despite the incorrect recitation of the year in which the '177 application was filed.

Verified Statement

Applicants hereby state that the entire delay between December 19, 2003, and the date of this petition was unintentional, in accordance with 37 C.F.R. § 1.78(a)(3)(iii).

Applicants first learned that there might be an issue of ambiguity in the recited priority claim involving Application No. 09/318,500 in connection with Patent Interference No. 105,555 (MPT), declared July 10, 2007, and included in its list of proposed motions a “motion with petition to the Board to accept an unintentionally delayed claim for the benefit of a prior-filed application under 37 C.F.R. § 1.78(a)(3), with proposed amendment to involved application no. 10/644,389 to properly claim benefit of priority to application no. 09/318,500 or other appropriate relief.” Applicants sought authorization for a motion, instead of petitioning the PTO immediately, as they understood Applicants must seek relief “in the form of a motion” under the Board’s Standing Order. The motion was authorized by Paper 22, filed August 29, 2007.

Applicants prepared and filed its motion, Senior Party Zook (PRC) Motion 2 (Miscellaneous Motion Requesting Acceptance of an Unintentionally Delayed Request for Priority Benefit with Appendices 1 through 6), on November 30, 2007. The papers filed included a petition and directed amendment of the first paragraph of the application, entitled “Cross-Reference to Related Applications.” (Exhibit 1; Motion 2 with Appendices 1-6, particularly Appendices 3 & 4).

The Board’s disposition of the interference did not include any ruling on Applicants’ Miscellaneous Motion, petition and supporting papers to perfect the previously claimed benefit of priority, filed November 30, 2007. Once aware that the Judgment (Paper No. 61), issued June 30, 2008, did not address the petition, Applicants requested that the Board forward their earlier request for relief to the Petitions Branch or grant leave to address the issue prior to the expiration of time for appeal or seeking other review, before which time no decision of the Board is

considered final. (Exhibit 2; Request dated July 11, 2008). As set forth in 35 U.S.C. §§ 141-142 & 146, appeal was available through August 29, 2008. Applicants' request for leave to seek relief prior to the finality of the Board's Judgment being perfected was dismissed as moot by the Board on July 17, 2008.

Applicants' representatives, Jerry Voight and Wesley Derrick, conferred with the responsible Examiner, Examiner Truong, by telephone on July 23, 2008, at which time the Examiner requested a paper copy of the previously filed Miscellaneous Motion, petition, and supporting papers to perfect the previously claimed benefit of priority. It was requested that these papers be forwarded with any other amendment or paper that Applicants were going to file. (Exhibit 3; Amendment, pp. 7-8).

As discussed with the Examiner, Applicants did prepare and file further papers in this case. The papers prepared included an amendment to the claims, remarks outlining the support for the as-amended claims, remarks noting that Applicants were forwarding the requested paper copy of the previously filed Miscellaneous Motion, petition, and supporting papers (as directed by the Examiner), remarks addressing certain allegations of a lack of written description and/or new matter made during the interference (as directed by the Board, Interference 105,555 (MPT), Paper 22, page 3, lines 17-19), and a further Information Disclosure Statement (IDS). These further papers were filed on October 8, 2008. (Exhibits 3 & 4; Amendment & Transmittal Letter, respectively).

The Amendment paper filed on October 8, 2008, referenced the motion, petition, and supporting papers, which included the requested amendment, stating:

As requested by the Office, a copy of the previously filed motion and associated papers is submitted herewith in paper form. Applicants submit that the motion and associated papers support the grant of the benefit of priority as set forth therein. Applicants

request that the Examiner forward the motion and associated papers to the Petition branch for processing.

(Exhibit 3; Amendment, pp. 7-8). Further, Applicants concluded with the statement that if “any of the papers submitted ... raise any questions, the Examiner is urged to contact Applicants’ attorney undersigned below” (Exhibit 3; Amendment, p. 9)(emphasis added). A paper copy of the Miscellaneous Motion, petition, and supporting papers originally filed on November 30, 2007, were submitted with the Amendment paper. Applicants were not contacted by the Examiner at any time and only became aware of the failure of the petition to be considered, and the directed amendment to be made, upon issuance of the Notice of Allowance, dated June 29, 2009.

Required Reference

Applicants provide herewith an amendment to the specification of the above-referenced application to insert the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2)(i), specifying the prior-filed application by its series code, serial number, and indicating the relationship between these applications. Applicants further correct the error in the filing date of Application No. 10/302,177. Applicants further note, and are considering as entered, the Examiner’s Amendment of June 18, 2009, that indicates that Application No. 10/302,177 is abandoned. As amended, the first paragraph of the application entitled “Cross-Reference to Related Applications” will read:

This application is a continuation of U.S. Patent Application No. 10/302,177, filed November 21, 2002, now abandoned; which is a continuation of U.S. Patent Application No. 09/756,573, filed January 8, 2001, now U.S. Patent No. 6,509,418 B1; which is a continuation-in-part of U.S. Patent Application No. 08/928,972, filed September 12, 1997, now U.S. Patent No. 6,172,179; which is a continuation-in-part of U.S. Patent Application 08/802,130, filed on

February 19, 1997, now U.S. Patent No. 5,912,319; said U.S. Patent Application No. 09/756,573 is also a continuation-in-part of U.S. Patent Application No. 09/318,500, filed May 25, 1999, now U.S. Patent No. 6,232,401; which is a division of said U.S. Patent Application No. 08/802,130, filed on February 19, 1997, now U.S. Patent No. 5,912,319; and said U.S. Patent Application No. 09/756,573 claims the benefit of U.S. Provisional Application No. 60/182,396, filed February 14, 2000, and U.S. Provisional Application No. 60/215,548, filed June 30, 2000, all of which are incorporated herein by reference.

Petition Fee under 37 C.F.R. § 1.17(t)

Applicants hereby authorize the PTO to charge the petition fee under 37 C.F.R. § 1.17(t) of \$1,410.00 to Deposit Account No. 06-0916.

Conclusion

As the requirements under 37 C.F.R. § 1.78(a)(3) for a petition to accept an unintentionally delayed claim for priority under 35 U.S.C. § 120 have been met, Applicants respectfully request that this petition be granted such that the Office recognizes this application's priority claim as set forth above. Please grant any extensions of time required to enter this petition, and should any additional fees be required for the consideration or acceptance of this petition, please charge them to Deposit Account No. 06-0916.

Respectfully submitted,

Date: August 6, 2009

By: Wesley Derrick
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